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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,979	01/10/2000	WILLIAM HILL	13237-1701/M	3757

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/07/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/479,979

Applicant(s)

HILL ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 35-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 35-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: application filed on 01/10/00 which is a continuation of the application 08/847,427 filed on 4/24/97, now US Pat No. 6,023,714.
2. Claims 1-34 are canceled.
3. Claims 35-53 are added.
4. Claims 35-53 are pending in the case. Claims 35, 42 and 48 are the independent claims.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103 ( c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 35, 42-43, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (US Pat No. 5,943,680, 8/24/99, filed 1/30/95).

Regarding independent claim 35, Shimizu discloses:

- creating a document with the characteristics such as color text, image, graphic (col 2, lines 39-49)
- indicating how the color text, image, and graphic form are shaped and composed in a manner independent of the type of display and printing devices (col 2, lines 50-53)
- shaping and composing the document including the color text, image, and graphic form on the basis of the contents as shown in the indicating step (col 2, lines 54-56)
- outputting the composed document including the color text, image, and graphic form so that the document can *conform to the performance of the display or printing device* (col 2, lines 56-59)

Shimizu does not disclose explicitly determining a set of the capabilities of the output device and selecting one of a plurality of style sheets based upon the set of capabilities of the output device.

However, the document in Shimizu has format properties, which are some of the properties included in the style sheets for documents. Further, the format of the document in Shimizu at first is different from the document format of the output device,

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and then *is formatted (shaped and composed) to conform to the performance of the display or printing device, which is an output device.*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have applied Shimizu since the above features of Shimizu suggest that the format properties of the document are formed based on the capabilities of an output device, the capabilities of the output device is determined, and style sheets related to said capabilities are selected. Otherwise, the output document can not conform to the performance of the output device.

Independent claim 42 includes limitations of claim 35, and is rejected under the same rationale except the added limitations: selecting *a layout generator* and generating the selected style sheet based upon the set of capabilities of the output device *using the layout generator.*

Since Shimizu discloses the ability to select a format for a document, which is equivalent to the style sheet of a document, so that the layout of the document conforms to the performance of the output device, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that these functions performed are equivalent to the functions of a layout generator as claimed. Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that using a unit as a layout generator implies that such a unit is selected for use.

Regarding independent claim 48, refer to claims 35 and 42. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that the added limitation "interrogating the output device to determine a set

of capabilities of the output device” is implied in “determining a set of capabilities of the output device”, which is mentioned in claim 35. The reason is that the system should question the output device to find out the capabilities it has.

Regarding claim 43, which is dependent on claim 42, as mentioned in claim 42, Shimizu does not explicitly disclose that the layout generator is a general purpose layout generator for use with a plurality of documents.

However, Shimizu relates to a document processing apparatus for creating and editing *documents, and the editing is carried out so that the document conform to the performance of the output device* (col 1, lines 13-14; col 2, lines 39-44). This shows that in Shimizu the document layout functions carried out are the same functions as that of the layout generator for use with a plurality of documents.

5. Claims 36-41, 44-47, 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu as applied to claims 35, 42, and 48 above, and further in view of Ferrel et al. (US Pat No. 5,860, 073, 1/12/99, filed 7/17/95).

Regarding claim 36, which is dependent on claim 35, Shimizu does not disclose that a layout generator is used for determining a set of the capabilities of the output device and selecting one of a plurality of style sheets based upon the set of capabilities of the output device.

Ferrel discloses a method to format a HTML document using the style sheet, which is a collection of formatting, that *allows users to select an appropriate document layout to display a document instead of following the format of the tagged document* (col 27, lines 36-55).

Since Ferrel provides a plurality of layout templates for documents so that users can *choose desired one*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that this fact suggests that a user can choose a layout that conforms the style sheets based on the capabilities of the output device, and suggests a unit that functions like a layout generator is included in Ferrel.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Ferrel to Shimizu to enhance the ability of selecting an appropriate format, for not only an ordinary document but also a HTML document, that conforms the capabilities of the output device.

Regarding claims 37, 44-45, 50, which are dependent on claims 35, 42, 48, respectively, Shimizu does not disclose that the layout generator is external to the document.

Ferrel discloses a method to formatting a HTML document using the style sheet, which is a collection of formats, that *allows users to select an appropriate document layout to display a document instead of following the format of the tagged document* (col 27, lines 36-55, figure 14). *Users can choose a desired style using the style sheet content dialog* (col 27, lines 36-55).

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that modifying the style sheet is *external to the document* (via the style sheet content dialog).

Regarding claims 38-41, 46-47, 49-52, which are dependent on claims 35, 42, 48, respectively, Ferrel discloses that the style sheet is embedded in the document, the style sheet comprises a style tag corresponding to the selected style sheet in the document, and the document includes a plurality of said tags (figure 14, col 33, lines 47-53, styles HEADING and PARAGRAPH are embedded in the document with the tag <H1>, </H1>, <P>, </P>, <H2>, </H2>).

Regarding claim 53, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that the document in Ferrel is a markup language document (figure 14).

### ***Double Patenting***

6: The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double



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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 35-53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-11, 14 and 19 of U.S. Patent No. 6,023,714. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose a method for formatting a document where the layout of the document is formed based on one of the style sheets conforming the capabilities of the output device.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Atkinson et al. (US Pat No. 6,064,406, 5/16/00, filed 11/7/96).

Streefkerk et al. (US Pat No. 6,104,470, 8/15/00, filed 7/1/98, priority 7/4/97).

SpyGlass, SpyGlass Internet Infrastructure Products Open Web to New Devices by Optimizing Performance and Enhancing User Experience,

<http://www.spyglass.com/newsflash/releases/96/120296infra.html>, 12/2/96.

SpyGlass, Spyglass Prism Content Conversion Solution Debuted at Embedded System East '97, <http://spyglass.com/newsflash/releases/97/031097/prism.html>, 3/10/97.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong Lac Huynh whose telephone number is (703) 305-0432. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. The fax number to this Art Unit is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 746-7239, (for formal communications intended for entry)

Or:

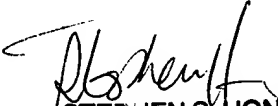
(703) 746-7240 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

clh

11/30/01

  
STEPHEN S. HONG  
PRIMARY EXAMINER